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PATENT

Practitioner's Docket No. 117163.00137

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PCT/EP03/12532	11 October 2003 (11.10.03)	13 November 02 (13.11.02)
International Application No.	International Filing Date	Priority Date Claimed

USE OF ONE OR MORE ELEMENTS FROM THE GROUP CONTAINING YTTRIUM,
NEODYMIUM AND ZIRCONIUM AND PHARMACEUTICAL COMPOSITIONS
CONTAINING SAID ELEMENTS

Title of Invention

HARDER, Claus and HEUBLEIN, Bernd

Applicant(s) for DO/US

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
ATTENTION: Office of PCT Legal Administration

RESPONSE TO COMMUNICATION REGARDING
SUBMISSION UNDER 37 CFR 1.42

This replies to the Communication Regarding Submission Under 37 C.F.R. 1.42.

A copy of the communication accompanies this response.

DECLARATION OR OATH

- I. Enclosed is a revised and re-executed declaration for this application which includes the citizenship of the deceased inventor as well as a statement confirming that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.

AKR - 110336.1

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EXTENSION OF TIME

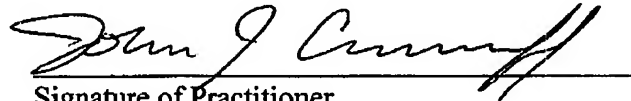
- II. The proceedings herein are for a patent application. The provisions of 37 C.F.R. section 1.1 36(a) apply.

Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 15-0450.

Date: 8 June 2006

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In re Application of:
HARDER, Claus, et al.
U.S. Application No.: 10/535,084
PCT No.: PCT/EP03/12532
International Filing Date: 10 November 2003
Priority Date: 13 November 2002
Attorney's Docket No.: 117163.00137
For: USE OF ONE OR MORE ELEMENTS FROM
THE GROUP CONTAINING YTTRIUM,
NEODYMIUM AND ZIRCONIUM AND
PHARMACEUTICAL COMPOSITIONS
CONTAINING SAID ELEMENTS

COMMUNICATION
REGARDING SUBMISSION
UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission on 08 December 2005 of a declaration executed on behalf of deceased inventor Bernd HEUBLEIN by his heirs, which has been treated as a submission under 37 CFR 1.42.

BACKGROUND

On 10 November 2003, applicants filed international application PCT/EP03/12532. The application claimed a priority date of 13 November 2002 and designated the United States. On 27 May 2004, the International Bureau ("IB") communicated a copy of the international application to the United States Patent And Trademark Office ("USPTO"). The deadline for payment of the basic national fee was 13 May 2005 (i.e., thirty months from the priority date).

On 13 May 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 05 October 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring the following: (1) a translation into English of the international application; (2) the processing fee for filing the translation later than thirty months after the priority date; (3) an oath or declaration in compliance with 37 CFR 1.497; and (4) the surcharge for filing the oath or declaration later than thirty months after the priority date.

On 08 December 2005, applicants filed a response to the Notification Of Missing Requirements. The response included an English translation of the international application,

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Application No. 10/535,084

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payment of the required surcharge and processing fees, and a declaration. The declaration was executed by surviving applicant Claus HARDER and on behalf of the deceased inventor Bernd HEUBLEIN by three persons identified as heirs: Eva HEUBLEIN, Nora HEUBLEIN, and Christoph HEUBLEIN. This declaration is considered herein under 37 CFR 1.42 and 1.497.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship for both the deceased inventor and the legal representative (or heirs) must be identified on the declaration (as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497).

Here, the declaration filed 06 January 2006 includes the required citizenship, residence, and mailing address information for the surviving inventor and the persons signing the declaration on behalf of the deceased inventor. However, the declaration does not set forth the citizenship of the deceased inventor. In addition, neither the declaration nor any materials submitted therewith state that the three heirs listed in the declaration are the only heirs of the deceased inventor. Applicants must provide a revised declaration that includes all required information, including the citizenship of the deceased inventor. Such declaration must also make clear on its face (or be accompanied by a statement and/or supporting documentation confirming) that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.

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It is also noted that the copy of the declaration in the application file is incomplete; page "2 of 3" (and the required language contained thereon) is missing. Any revised declaration filed herein must be complete.

CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment. Extensions of time are available under 37 CFR 1.136(a).

A proper response must include a revised and re-executed declaration that includes all the information required by 37 CFR 1.497 (including the citizenship of the deceased inventor) as well as a statement and/or supporting documentation confirming that the persons executing the declaration on behalf of the deceased inventor are the only heirs of the deceased inventor.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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To:	PCT LEGAL DEPARTMENT Richard M Ross	From:	John J. Cunniff
Fax:	571-273-8300	Pages:	11
Phone:		Date:	6/8/2006
Re:	Communication Regarding Submission Under 37 CFR 1.42	CC:	

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• **Comments:**

Re: International Application No. PCT/EP03/12532

Title: USE OF ONE OR MORE ELEMENTS FROM THE GROUP CONTAINING YTTRIUM,
NEODYMIUM AND ZIRCONIUM AND PHARMACEUTICAL COMPOSITIONS
CONTAINING SAID ELEMENTS

Please see attachments.

Thank you.

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